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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/017,746	12/07/2001	Van Barlow	510P004	8798

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EXAMINER

LOPEZ, MICHELLE

ART UNIT PAPER NUMBER

3721

DATE MAILED: 09/03/2003

7

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	10/017,746	BARLOW ET AL.
	Examiner	Art Unit
	Michelle Lopez	3721

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1) Responsive to communication(s) filed on 11 July 2003.

2a) This action is FINAL.      2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4) Claim(s) 1-13 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 1-13 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some \* c) None of:

1. Certified copies of the priority documents have been received.

2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.

3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) The translation of the foreign language provisional application has been received.

15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

1) Notice of References Cited (PTO-892)

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5.

4) Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_.

5) Notice of Informal Patent Application (PTO-152)

6) Other: \_\_\_\_\_

**DETAILED ACTION**

1. This action is in response to applicant's amendment received on July 07, 2003.

*Claim Objections*

2. Claim 13 is objected to because of the following informalities: the last line of the claim appears to be incomplete. Appropriate correction is required.

*Claim Rejections - 35 USC § 112*

3. Claims 1-7 and 13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In claims 1 and 13, it is not clear what is the scope of the claims. The preamble of claims 1 and 13 recite a fastening tool for fastening an object to a substrate, yet further claim details of the fasteners to be driven. Therefore it is not clear as to whether the applicant is claiming a combination of a tool and the fasteners, or just the tool. If applicant is claiming the combination, then the combination should be stated on the preamble.

*Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-7 and 13 are rejected under 35 U.S.C. 102(b) as being anticipated by Dennis (US Pat. ~~5,178,903~~<sup>6082,604</sup>). Dennis discloses the invention substantially as claimed including a housing "A", a driver "E", an actuator "B", a detachable magazine assembly "100", one or more staples "300", a nose "W", a tail end (see Fig. 1), a pusher "250", a staple bight portion and a pair of legs (see Fig. 20). The particulars of the fasteners are given no patentable weight, since they are not positively claimed, *per se*. Only a fastener-driving tool appears to be claimed, which Dennis discloses. Further, the tool of Dennis is capable of driving the specifically claimed fasteners if desired; i.e. the tool is capable of the intended use.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 8-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dennis' 604 in view of Kish'373 and further in view of Lat'903. Dennis'604 discloses the invention substantially as claimed including a staple "300" for securing a wire to a substrate (see col. 1, lines 11-16) having a bight portion and a pair of legs (see Fig.20). Dennis'604 does not disclose a dielectric coating coated to the bight portion and the pair of legs forming an insulated staple. However, Kish'373 teaches a dielectric coating coated to the bight portion and the pair of legs for the purpose of forming an insulated staple. In view of Kish'373, it would have been obvious to one having ordinary skill in the art to have modified Dennis' invention as taught by Kish'373

including a dielectric coating coated to the bight portion and the pair of legs in order to form an insulated staple. Also, Dennis'604 does not disclose that coating is uniformly coated on the staple. However, Lat'903 teaches a uniformly coating on a staple "30" for the purpose of providing an integral unitary structure. In view of Lat'903, it would have been obvious to one having ordinary skill in the art to have modified Dennis' invention as taught by Lat'903 including a uniformly coating on a staple in order to provide an integral unitary structure wherein the coating remains stationary on the staple after the staple being fastened to a substrate.

Regarding claim 10, it would have been obvious to one having ordinary skill in the art to have provided Dennis' invention including a coating thickness range from about 0.001 inches to 0.050 inches as a matter of design choice.

Regarding claim 11, Dennis'604 does not specifically state that the staples are made of steel. However, Kish'373 teaches a staple made of steel (col. 1, lines 34-35) for the purpose of providing a staple with the required hardness and stiffness properties. In view of Kish', it would have been obvious to one having ordinary skill in the art to have modified Dennis' invention as modified by Kish'373 having a staple made of steel in order to provide a staple with the required hardness and stiffness properties assuring the penetration and fastening of the staple into a substrate.

Regarding claim 12, Dennis'604 does not disclose that each free end of the staple terminates in an angled cut. However, Kish'373 teaches a staple with angled cut free ends for the purpose of facilitating the penetration of the staple into a substrate. In view of Kish'373, it would have been obvious to one having ordinary skill in the art to have modified Dennis' invention as

modified by Kish'373 having a staple with angled cut free ends in order to facilitate the penetration of the staple into a substrate.

***Response to Arguments***

6. Applicant's remarks have been fully considered but they are not deemed moot in view of the new grounds of rejection.
7. For the reasons above in paragraphs 2-5, the ground of rejection are deem proper.
8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).
9. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

***Conclusion***

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michelle Lopez whose telephone number is 703-305-8205. The examiner can normally be reached on Monday - Thursday: 8:00 am - 6:00 pm.

11. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rinaldi Rada can be reached on 703-308-2187. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9302 for regular communications and 703-872-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1148.



SCOTT A. SMITH  
PRIMARY EXAMINER